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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/735,872	12/16/2003	Akiko Sato	NITT.0168	5448
38327	7590	11/21/2007		
REED SMITH LLP 3110 FAIRVIEW PARK DRIVE, SUITE 1400 FALLS CHURCH, VA 22042			EXAMINER RANKINS, WILLIAM E	
			ART UNIT	PAPER NUMBER
			4172	
			MAIL DATE	DELIVERY MODE
			11/21/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/735,872

**Applicant(s)**

SATO ET AL.

**Examiner**

William E. Rankins

**Art Unit**

4172

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

1. Claims 1-9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer. See MPEP 2106.01.

### ***Claim Rejections - 35 USC § 112***

2. Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1-4 recite the limitation "credit service" and "credit service provider" in lines 16, 18 and 19. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshida (5,144,115) as applied to claim 1 above, and further in view of Martin (6,304,860).

As per claim 1;

Yoshida discloses:

A program for controlling a bank service provider system performing banking functions, said bank service provider system comprising:

a client for bank service provider to be connected to an IC card (Col. 4, lines 13-21); and

a server for bank service provider performing banking functions on a user's bank account for automatic deduction in which the user's money is to be deposited (Col. 4, lines 13-21, apparatus directed toward banking functions), wherein said program enables said server for bank service provider to execute the steps of:

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causing said bank service provider to reflect a deposit by said user in said bank account for automatic deduction (Col. 4, lines 13-21);

storing deposit information certifying said deposit into the IC card via said client for bank service provider (Col. 4, lines 13-21).

Yoshida does not disclose:

Transferring the money to pay for the use of credit service on the basis of a financial status in which said deposit information is reflected from said bank account to said credit service provider system.

However, Martin discloses:

A system that interfaces between a bank and a creditor to facilitate payments to the creditor (Col. 4, lines 33-37).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of this invention to combine the systems of Yoshida and Martin et al. One of ordinary skill in the art would be motivated to do so in order to convey banking account status off-line.

As per claim 2;

Martin et al. discloses:

The program according to Claim 1, wherein said bank account is a common bank account for pooling sums to be transferred to said credit service provider system and

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allows no withdrawal by any user once he or she has made a deposit in it (Col. 6, Lines 32-38 and 63-65).

As per claim 3;

Martin discloses:

The program according to Claim 1, wherein said deposit information includes at least the sum deposited (Col. 2, lines 54-56).

4. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshida (5,144,115), in view of Martin (6,304,860) as applied to claim 1 above, and further in view of Official Notice.

As per claim 4;

Yoshida and Martin do not disclose:

The program according to Claim 1, wherein at the step of storing deposit information certifying said deposit into the IC card, said program enables said server for bank service provider to execute the steps of:

encrypting said deposit information with a public key of said credit service provider system; and

assigning a signature with a secret key of said bank service provider system.

However, Official Notice is taken that encryption of sensitive data was old and well known in the art at the time of this invention.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of this invention to combine the systems of Yoshida, Martin et al. and encryption. One of ordinary skill in the art would be motivated to do so in order to provide secure transactions and protect sensitive data.

5. Claim 5-7, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamauchi et al. (JP 2001143007), in view of Martin et al. (6,304,860).

As per claim 5;

Yamauchi discloses:

A program for controlling a credit service provider system performing credit service, said credit service provider system comprising:

clients for credit service provider each to be connected to an IC card; and  
a server for credit service provider which has a financial status database for managing data related to financial statuses of users and performing credit service, wherein said program enables said server for credit service provider to execute the steps of:

receiving from the IC card, via one of said clients for credit service provider, deposit information certifying a deposit by a user into a bank account for automatic deduction;

causing said deposit information to be reflected in data related to financial status managed by said financial status database;

determining the availability of credit service to said user on the basis of said data related to financial status and providing credit service to the user via said clients for credit service provider (Abstract); and

Yamauchi et al. does not disclose:

receiving a transfer of payment for the use of said credit service from a bank account managed by said bank service provider system performing banking functions.

However, Martin et al. discloses:

A system that interfaces between a bank and a creditor to facilitate payments to the creditor (Col. 4, lines 33-37).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of this invention to combine the systems of Yamauchi et al. and Martin et al. One of ordinary skill in the art would be motivated to do so in order to convey account status off-line.

Claim 6 is rejected under the same rationale used to reject claim 2 with respect to Yamauchi et al. and Martin et al.

Claim 7 is rejected under the same rationale used to reject claim 3 with respect to Yamauchi et al. and Martin et al.

As per claim 9;

Yamauchi et al. discloses:

The program according to Claim 7, wherein at the step of determining the availability of credit service to said user on the basis of said data related to financial status and making the credit service available, said program enables said server for credit service provider to execute the steps of:

causing said sum deposited in said deposit information to be temporarily reflected in the credit limit in said data related to financial status; and

assessing the temporarily reflecting credit limit in comparison with the sum of a requested transaction on credit (abstract).

6. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yamauchi et al. (JP 2001143007), in view of Martin (6,304,860) as applied to claim 1 above, and further in view of Official Notice.

As per claim 8;

Claim 8 is rejected under the same rationale used to reject claim 4.

Claim 4 does not address the additional limitation of decrypting.

However, Official notice is also taken that decrypting was old and well know in the art at the time of this invention.

7. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshida (5,144,115), in view of Martin (6,304,860) and further in view of Yamauchi et al. (JP 2001143007).

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As per claim 10

Yoshida discloses:

An IC card with a built-in IC chip comprising a memory and a communication unit (Col. 7, lines 18-21), wherein said IC card receives from a bank service provider system performing banking functions, via the communication unit, deposit information certifying a deposit by a user into a bank account for automatic deduction, stores said deposit information into said memory (Col. 4, lines 13-21).

Yoshida does not disclose"

When said user is to make use of credit service, provides said deposit information stored via said communication unit to a credit service provider system performing said credit service.

However, Yamauchi et al. discloses:

Deposit information stored on an IC card used to determine allowable transactions based on available balance and transaction costs (abstract).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of this invention to combine the systems of Yoshida and Yamauchi et al. One of ordinary skill in the art would be motivated to do so in order to enable a user to conduct transactions without connecting to the bank service provider system.

As per claim 11;

Yoshida and Yamauchi et al. disclose:

The IC card according to Claim 10.

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Yoshida and Yamauchi et al. do not disclose:

Wherein said bank account is a common bank account for pooling sums to be transferred to said credit service provider system and allows no withdrawal by any user once he or she has made a deposit in it.

However, this additional limitation is rejected under the same rationale used to reject claim 2 by Martin et al.

As per claim 12;

Yoshida, Yamauchi et al. and Martin et al. disclose:

The IC card according to Claim II.

As in claim 3, Martin et al. also discloses:

Wherein said deposit information includes at least the sum deposited.

The rationale used to reject claim 3 is also used here.

8. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshida (5,144,115), in view of Martin (6,304,860), further in view of Yamauchi et al. (JP 2001143007) and further in view of Official Notice.

As per claim 13;

Yoshida, Yamauchi et al. and Martin et al. disclose:

The IC card according to Claim 12.

Yoshida, Yamauchi et al. and Martin et al. do not disclose:

Wherein in storing said deposit information into said memory or providing said deposit information which is stored, said bank service provider system and credit s service provider system exchange in advance public keys matching secret keys they respectively hold.

However, Official Notice is taken that it was old and well known in the art at the time of this invention to use encryption to securely transmit data.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of this invention to combine the systems of Yoshida, Yamauchi et al., Martin et al. and encryption techniques. One of ordinary skill in the art would be motivated to do so in order to provide secure transactions and protect sensitive data.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William E. Rankins whose telephone number is 571-270-3465. The examiner can normally be reached on M-F 7:30 AM - 5:00 PM, off alt Fridays beg 6/15/07.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Dixon can be reached on 571-272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Naeem Haq/  
Primary Examiner, Art Unit 4172

William E Rankins  
Examiner  
Art Unit 4172

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